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Amdt. Dated February 9, 2006
Response to Office action of January 6, 2006

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REMARKS/ARGUMENTS

Specification

A typographical error has been corrected at Pages 1 and 2 of the specification. The Applicants submit that this amendment introduce no new matter.

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Claim Rejections – 35 USC § 103

At page 3 of the Office Action, the Examiner rejects claims 1 and 11-29 as being unpatentable over Milovanovic et al. (US Patent No. 6,484,198) in view of Bobrow et al (US Patent No. 6,275,301).

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

The MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The Examiner has stated on page 2 of the Office Action that "*However, Bobrow et al teach (sic) an inventive concept of identifying from the identity data, a user account...*".

The Applicant submits that Bobrow et al. fails to teach this feature of identifying, from the identity data, a user account. The Examiner has highlighted column 32 of Bobrow et al. There are two references to a commercial transaction in column 32. In particular, lines 28 to 29 which state:

"The user is billed accordingly, and appropriate copyright royalties flow to the copyright holder."

Additionally, lines 55 to 59 of column 32 of Bobrow et al. states:

"Upon issuance of the request, combined with appropriate payment or credit as indicated by arrow 2525, the user's order is transmitted to a print show or other trusted printing facility, along with a high-resolution representation of the document."

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These are the only two references in column 32 of Bowbrow et al with regard to payment from the user. It is apparent that there is absolutely no reference in Bowbrow et al to any identity data. Furthermore, there is absolutely no reference in Bowbrow et al to any user account. In fact, there is absolutely no reference, teaching or suggestion in Bowbrow of the feature of *'identifying, from the identity data, a user account'*.

Bowbrow only teaches that a financial payment can be transferred in the request, and that the copyright holder can receives copyright royalties.

Therefore, when a person skilled in the art would consider combining the teachings of Milovanovic et al. with Bowbrow et al., it would be apparent that a request for a document could be received by a computer system, wherein the request would be indicative of an identity of the user and payment for the document, and that copyright royalties can be paid to the copyright owner for the request of the document. The document can then be provided to the user.

However, there is no teaching or suggestion from either document that the identity of the user is used by the computer system to identify a user account which is subsequently debited. Milovanovic et al at teaches at lines 26-29 that:

"At this point, the publisher 30 may wish to verify 40 the authenticity of the user prior to checking 44 if an electronic equivalent 32 of the requested object is available."

Therefore, Milovanovic et al teaches that the request is used to check the authenticity of the user. There is no suggestion and no teaching in Milovanovic et al that the user identity is used to identify a user account which can subsequently be debited. Furthermore, Bowbrow et al fails to teach any form of transfer of user identity, and fails to teach using a user account.

Therefore, a skilled person, based on the teachings and suggestions of Milovanovic et al in view of Bowbrow et al, would only fairly consider using the identity of the user for authenticity purposes. It would not be apparent, based on the descriptions of Milovanovic et al and Bowbrow et al that the user identity would be used by the computer system for *'identifying, from the identity data, a user account'*, as required by claim 1.

Therefore, the applicant submits that the Examiner has failed to prove a prima facie case of obviousness based on the teachings of Milovanovic et al in view Bowbrow et al.

In particular, the first basic requirement of a prima facie case of obviousness has not been shown by the Examiner as there is no suggestion and no motivation, in the references themselves, to modify the references such as to show the feature of *'identifying, from the identity data, a user account'*.

Furthermore, the third basic requirement of a prima facie case of obviousness has not been shown by the Examiner as the prior art reference (or references when combined) does not teach and does not suggest all the claim limitations of claim 1 including *'identifying, from the identity data, a user account'*.

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As all three basic requirements for a prima facie case of obviousness must be shown in order to reject a claim as obvious and thus unpatentable, the Applicant respectfully submits that this claim rejection should be withdrawn as the Examiner has not satisfied all three basic requirements to reject claim 1.

The Applicant also notes that in the previous response to the Office Action a number of dependent claims were highlighted as being patentable over the cited documents. In this Office Action it is apparent that the Examiner has not substantially reconsidered any of these dependent claims, but has only concentrated on the independent claim.

The Applicant respectfully reminds the Examiner that all claims should be considered individually. By restating the previous reasoning for rejection, the Applicant respectfully submits that the Examiner is not substantially cooperating with the Applicant to progress the prosecution of the application.

For example, the Applicant highlights claim 13 which specifies that '*at least some of the coded data is coincident to the visible information*'. The Examiner has restated on page 3 of the Office Action that "*Milovanovic et al teach (sic) a method wherein the document includes visible information and wherein at least some of the coded data is coincident to the visible information (see column 4 lines 5-5 line 67)*".

However, column 4 has no reference to at least some of the coded data being coincident with the visible information. In fact, if the Examiner turns to Figure 3, it is apparent that page represented by integer 18 includes coded data represented by integers 116 and 118 which are not even remotely coincident with the visible information represented by integers 110, 112, and 114. It is apparent from Figure 3 that the coded data is positioned on the page in a totally separate location compared to the visual information. Therefore the applicant respectfully questions, based on the Examiner's justification in the Office Action, how can at least some of the coded data be coincident with the visual information when clearly Milovanovic et al teaches the very opposite?

The Applicant considers that there are a number of inventive features in the dependent claims which the Examiner has failed to fairly consider based on the cited documents which he has raised in the Office Action.

The Examiner is reminded that the MPEP states at §704.14(b):

"The examiner must consider the information submitted with the applicant's reply and apply the information as the examiner deems appropriate."

In regard to the Examiner issuing a the Office Action as being Final, the Examiner is reminded that the MPEP states at §706.07:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending

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before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

...
The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

The Applicant did not amend the claims in the response to the previous Office Action, and in the previous response was only trying to define his claim that will give him the patent protection to which he deserves. The Examiner has issued a final rejection based on the documents cited and the justification provided in the Office Action. It is clear that the Applicant has been prematurely cut off from prosecution of the Applicant's application without any substantial cooperation from the Examiner.

The Applicant respectfully requests that the Examiner reconsider the Final rejection based on the above comments and also in view of the highlighted sections of the MPEP.

We would also like to clarify with the Examiner that the Office Action Summary indicates that 1 and 11-29 in the current application are pending, but that claims 1 and 22-29 are rejected. This seems to be contrary to the Examiner's comments in the Office Action. Therefore, we respectfully request that the Examiner clarify this discrepancy.

Reconsideration and withdrawal of this rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102(a) and 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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